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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/989,077 | 11/21/2001 | Detlef Selent | 215151US0 | 9763 |
| 22850 | 7590 | 04/26/2004 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | ROBINSON, BINTA M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1625 | |

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,077

Applicant(s)

SELENT ET AL.

Examiner

Binta M. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring, none of the substituents on the ring(s) can be heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and none of the radicals of W and X can be covalently linked to one another, classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

- II. Claims 1-6, drawn to drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring of the formula III in claim 3, the at least one of the R₁₂-R₁₇ or R₂₁-R₂₈ can be a heterocyclic or aliphatic-heterocyclic ring, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and W and X are covalently linked to one another, classified in class 564, subclass 13.

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If this group is elected, applicant will also be required to elect a single disclosed species.

- III. Claims 1-6, drawn to the to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, at least one of the radicals R₂-R₉ is an aliphatic-heterocyclic or heterocyclic group and the rest of the radicals R₂-R₉ are as claimed, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring, none of the substituents on the ring(s) can be heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and none of the radicals of W and X can be covalently linked to one another, classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

- IV. Claims 1-6, drawn to drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, at least one of R₂-R₉ is an aliphatic-heterocyclic or heterocyclic group and the remainder of the radicals R₂-R₉ are as claimed, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring of the formula III in claim 3, the at least one of the R₁₂-R₁₇ or R₂₁-R₂₈ can be a heterocyclic or aliphatic-heterocyclic ring, W and X can be any radical claimed except heterocyclic

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or aliphatic-heterocyclic, and are not covalently linked to one another ,
classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

- V. Claims 1-6, drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and none of the radicals of W and X can be covalently linked to one another ,
classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

- VI. Claims 1-6, drawn to drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, , W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and W and X are covalently linked to one another , classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

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- VII. Claims 1-6, drawn to the to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR1 wherein R1 is as claimed, at least one of the radicals R2-R9 is an aliphatic-heterocyclic or heterocyclic group and the rest of the radicals R2-R9 are as claimed, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and none of the radicals of W and X can be covalently linked to one another , classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

- VIII. Claims 1-6, drawn to drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR1 wherein R1 is as claimed, at least one of R2-R9 is an aliphatic-heterocyclic or heterocyclic group and the remainder of the radicals R2-R9 are as claimed, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and W and X can be covalently linked to one another , classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

- IX. Claims 1-6, drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR1 wherein R1 is as claimed, R2-R9 are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-

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heterocyclic, and if Q is aromatic or aromatic-aromatic ring, none of the substituents on the ring(s) can be heterocyclic, either W and X or both are heterocyclic or aliphatic-heterocyclic, whereas the other W or X that is not heterocyclic or aliphatic-heterocyclic, can be any of the other radicals claimed for W or X, and none of the radicals of W and X can be covalently linked to one another, classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

- X. Claims 1-6, drawn to drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring of the formula III in claim 3, the at least one of the R₁₂-R₁₇ or R₂₁-R₂₈ can be a heterocyclic or aliphatic-heterocyclic ring, either W and X or both are heterocyclic or aliphatic-heterocyclic, whereas the other W or X that is not heterocyclic or aliphatic-heterocyclic, can be any of the other radicals claimed for W or X, and W and X are covalently linked to one another, classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

- XI. Claims 1-6, drawn to the to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, at least

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one of the radicals R2-R9 is an aliphatic-heterocyclic or heterocyclic group and the rest of the radicals R2-R9 are as claimed, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring, none of the substituents on the ring(s) can be heterocyclic, either W and X or both are heterocyclic or aliphatic-heterocyclic, whereas the other W or X that is not heterocyclic or aliphatic-heterocyclic, can be any of the other radicals claimed for W or X, and none of the radicals of W and X can be covalently linked to one another, classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

XII. Claims 1-6, drawn to drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR1 wherein R1 is as claimed, at least one of R2-R9 is an aliphatic-heterocyclic or heterocyclic group and the remainder of the radicals R2-R9 are as claimed, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring of the formula III in claim 3, at least one of the R12-R17 or R21-R28 can be a heterocyclic or aliphatic-heterocyclic ring, either W and X or both are simultaneously heterocyclic or aliphatic-heterocyclic, whereas the other W or X that is not heterocyclic, are the other moieties claimed, and W and X are not covalently linked to one another, classified in class 564, subclass 13.

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If this group is elected, applicant will also be required to elect a single disclosed species.

XIII. Claims 1-6, drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, either W and X or both are simultaneously heterocyclic or aliphatic-heterocyclic, whereas the other W or X that is not heterocyclic, are the other moieties claimed and none of the radicals of W and X can be covalently linked to one another, classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

XIV. Claims 1-6, drawn to drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, either W and X or both are simultaneously heterocyclic or aliphatic-heterocyclic, whereas the other W or X that is not heterocyclic, are the other moieties claimed, and none of the radicals of W and X can be covalently linked to one another, classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

XV. Claims 1-6, drawn to drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are

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all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, , W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and none of the radicals of W and X can be covalently linked to one another , classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

XVI. Claims 1-6, drawn to the to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, at least one of the radicals R₂-R₉ is an aliphatic-heterocyclic or heterocyclic group and the rest of the radicals R₂-R₉ are as claimed, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and none of the radicals of W and X can be covalently linked to one another , classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

XVII. Claims 1-6, drawn to drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, at least one of R₂-R₉ is an aliphatic-heterocyclic or heterocyclic group and the remainder of the radicals R₂-R₉ are as claimed, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, W and X can be any radical

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claimed except heterocyclic or aliphatic-heterocyclic, and W and X can be covalently linked to one another, classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

XVIII. Claims 1-6, drawn to drawn to the phosphinine compound of formula I

wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring of the formula III in claim 3, the at least one of the R₁₂-R₁₇ or R₂₁-R₂₈ can be a heterocyclic or aliphatic-heterocyclic ring, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and W and X are covalently linked to one another, classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

XIX. Claims 1-6, drawn to drawn to the phosphinine compound of formula I

wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q is heterocyclic or aliphatic-heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and W and X are covalently linked to one another, classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

XX. Claims 7-13, drawn to the phosphinine-metal complex of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring, none of the substituents on the ring(s) can be heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and none of the radicals of W and X can be covalently linked to one another, classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

XXI. Claims 7-13, drawn to drawn to the phosphinine-metal complex of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring of the formula III in claim 3, the at least one of the R₁₂-R₁₇ or R₂₁-R₂₈ can be a heterocyclic or aliphatic-heterocyclic ring, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and W and X are covalently linked to one another, classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

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XXII. Claims 7-13, drawn to the to the phosphinine-metal complex of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, at least one of the radicals R₂-R₉ is an aliphatic-heterocyclic or heterocyclic group and the rest of the radicals R₂-R₉ are as claimed, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring, none of the substituents on the ring(s) can be heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and none of the radicals of W and X can be covalently linked to one another, classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

XXIII. Claims 7-13, drawn to drawn to the phosphinine-metal complex of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, at least one of R₂-R₉ is an aliphatic-heterocyclic or heterocyclic group and the remainder of the radicals R₂-R₉ are as claimed, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring of the formula III in claim 3, the at least one of the R₁₂-R₁₇ or R₂₁-R₂₈ can be a heterocyclic or aliphatic-heterocyclic ring, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, are covalently linked to one another, classified in class 556, subclass 19.

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If this group is elected, applicant will also be required to elect a single disclosed species.

XXIV. Claims 7-13, drawn to the phosphinine-metal complex of formula I

wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and none of the radicals of W and X can be covalently linked to one another, classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

XXV. Claims 7-13, drawn to drawn to the phosphinine-metal complex of formula

I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, , W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and W and X are covalently linked to one another, classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

XXVI. Claims 7-13, drawn to the to the phosphinine-metal complex of formula I

wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, at least one of the radicals R₂-R₉ is an aliphatic-heterocyclic or heterocyclic group and the rest of the radicals R₂-R₉ are as claimed, M is as claimed, Q can

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be heterocyclic or aliphatic-heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and none of the radicals of W and X can be covalently linked to one another, classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

XXVII. Claims 7-13, drawn to drawn to the phosphinine-metal complex of formula

I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, at least one of R₂-R₉ is an aliphatic-heterocyclic or heterocyclic group and the remainder of the radicals R₂-R₉ are as claimed, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and W and X can be covalently linked to one another, classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

XXVIII. Claims 7-13, drawn to the phosphinine –metal complex of formula I

wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring, none of the substituents on the ring(s) can be heterocyclic, either W and X or both are heterocyclic or aliphatic-heterocyclic, whereas the other W or X that is not heterocyclic or aliphatic-heterocyclic, can be any of the other radicals

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claimed for W or X, and none of the radicals of W and X can be covalently linked to one another, classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

XXIX. Claims 7-13, drawn to the phosphinine-metal complex of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring of the formula III in claim 3, then at least one of the R₁₂-R₁₇ or R₂₁-R₂₈ can be a heterocyclic or aliphatic-heterocyclic ring, either W and X or both are heterocyclic or aliphatic-heterocyclic, whereas the other W or X that is not heterocyclic or aliphatic-heterocyclic, can be any of the other radicals claimed for W or X, and W and X are covalently linked to one another, classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

XXX. Claims 7-13, drawn to the phosphinine-metal complex of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, at least one of the radicals R₂-R₉ is an aliphatic-heterocyclic or heterocyclic group and the rest of the radicals R₂-R₉ are as claimed, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring, none of the substituents on the

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ring(s) can be heterocyclic, either W and X or both are heterocyclic or aliphatic-heterocyclic, whereas the other W or X that is not heterocyclic or aliphatic-heterocyclic, can be any of the other radicals claimed for W or X , , and none of the radicals of W and X can be covalently linked to one another , classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

la . Claims 7-13, drawn to drawn to the phosphinine-metal complex of formula I wherein n is 0 or 1, Y is O, NH, NR1 wherein R1 is as claimed, at least one of R2-R9 is an aliphatic-heterocyclic or heterocyclic group and the remainder of the radicals R2-R9 are as claimed, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring of the formula III in claim 3, at least one of the R12-R17 or R21-R28 can be a heterocyclic or aliphatic-heterocyclic ring, either W and X or both are simultaneously heterocyclic or aliphatic-heterocyclic, whereas the other W or X that is not heterocyclic, are the other moieties claimed, and W and X are covalently linked to one another , classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

lia Claims 7-13, drawn to the phosphinine-metal complex of formula I wherein n is 0 or 1, Y is O, NH, NR1 wherein R1 is as claimed, R2-R9 are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as

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claimed, Q can be heterocyclic or aliphatic-heterocyclic, either W and X or both are simultaneously heterocyclic or aliphatic-heterocyclic, whereas the other W or X that is not heterocyclic, are the other moieties claimed and none of the radicals of W and X can be covalently linked to one another, classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

IIIa. Claims 7-13, drawn to drawn to the phosphinine compound of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, either W and X or both are simultaneously heterocyclic or aliphatic-heterocyclic, whereas the other W or X that is not heterocyclic, are the other moieties claimed, and none of the radicals of W and X can be covalently linked to one another, classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

IVa. Claims 7-13, drawn to drawn to the phosphinine-metal complex of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic,

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and none of the radicals of W and X can be covalently linked to one another , classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

Va. Claims 7-13, drawn to the to the phosphinine-metal complex of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, at least one of the radicals R₂-R₉ is an aliphatic-heterocyclic or heterocyclic group and the rest of the radicals R₂-R₉ are as claimed, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and none of the radicals of W and X can be covalently linked to one another , classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

Vla. Claims 7-13, drawn to drawn to the phosphinine-metal complex of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, at least one of R₂-R₉ is an aliphatic-heterocyclic or heterocyclic group and the remainder of the radicals R₂-R₉ are as claimed, M is as claimed, Q can be heterocyclic or aliphatic-heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and W and X can be covalently linked to one another , classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

VIIa. Claims 7-13, drawn to drawn to the phosphinine-metal complex of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q can be any moiety claimed except heterocyclic or aliphatic-heterocyclic, and if Q is aromatic or aromatic-aromatic ring of the formula III in claim 3, the at least one of the R₁₂-R₁₇ or R₂₁-R₂₈ can be a heterocyclic or aliphatic-heterocyclic ring, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and W and X are covalently linked to one another, classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

VIIIa. Claims 7-13, drawn to drawn to the phosphinine-metal complex of formula I wherein n is 0 or 1, Y is O, NH, NR₁ wherein R₁ is as claimed, R₂-R₉ are all the radicals claimed except aliphatic-heterocyclic or heterocyclic, M is as claimed, Q is heterocyclic or aliphatic-heterocyclic, W and X can be any radical claimed except heterocyclic or aliphatic-heterocyclic, and W and X are covalently linked to one another, classified in class 556, subclass 19.

If this group is elected, applicant will also be required to elect a single disclosed species.

IXa. Claims 14 and 16, drawn to a process comprising hydroformylating an olefin wherein the phosphinine claimed in claim 1 and is present in the olefin, classified in class 564, subclass 13.

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If this group is elected, applicant will also be required to elect a single disclosed species.

Xa Claims 15, 17, drawn to a process comprising hydroformylating an olefin wherein the phosphinine –metal complex claimed in claim 7 is used as a catalyst, classified in class 564, subclass 13.

If this group is elected, applicant will also be required to elect a single disclosed species.

The inventions are distinct, each from the other because of the following reasons:

In the instant case the different inventions have achieved a separate status in the art, have separate fields that aren't coextensive, and are capable of supporting separate patents. Further, a prior art reference that would anticipate the claims under 35 USC 102(b) would not render obvious the same claim(s) under 35 U. S. C. 103 (a) with respect to another member. Searching the entire genus would be a burden on the USPTO in terms of time and expense.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Groups I-VIIIa and IX a –Xa are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using the product (MPEP 806.05(h)). In the instant case, the product as

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claimed can be used in a materially different process of using that product as demonstrated throughout the specification and in claims 14-17 which are directed to several different methods of using the product, for example as a catalyst or as a ligand present in the olefin.

Advisory of Rejoinder

The following is a recitation of M.P.E.P. §821.04, Rejoinder:

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02© and § 821 through § 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Where product and process claims are presented in a single application and that application qualifies under the transitional restriction practice pursuant to 37 CFR 1.129(b), applicant may either (1) elect the invention to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) and have the additional inventions searched and examined under 37 CFR 1.129(b)(2), or (2) elect the invention to be searched and examined and not pay the additional fee (37 CFR 1.129(b)(3)). Where no additional fee is paid, if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims which either depend from or include all the limitations of the allowable product will be rejoined . If applicant chooses to pay the fees to have the additional inventions searched and examined pursuant to 37 CFR 1.129(b)(2), even if the product is found allowable, applicant would not be entitled

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to a refund of the fees paid under 37 CFR 1.129(b) by arguing that the process claims could have been rejoined. 37 CFR 1.26 states that "[m]oney paid by actual mistake or in excess will be refunded, but a mere change of purpose

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703)305-3592, and (703)305-3014.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)-272-1600.

A handwritten signature in black ink, appearing to be the initials 'BMR' followed by a horizontal line.

BMR
April 19, 2004